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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/040,843	01/07/2002	James Samsouard	31773-CIP1	3741

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EXAMINER

LIN, JERRY

ART UNIT PAPER NUMBER

1631

DATE MAILED: 09/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/040,843

Applicant(s)

SAMSOONDAR, JAMES

Examiner

Jerry Lin

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2006.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12-18,20,22 and 29-40 is/are pending in the application.
4a) Of the above claim(s) _____ is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 12-18,20,22 and 29-40 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. Applicants' arguments, filed July 11, 2006, have been fully considered and they are not deemed to be persuasive. The following rejections are reiterated. They constitute the complete set presently being applied to the instant application.

Status of the Claims

Claims 12-18, 20, 22, and 29-40 are under examination.

Claims 1-11, 19, 21, and 23-28 are cancelled (1-11 and 23-28 were unelected).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 12, 13, 15-17, 20, 22, 29-35, and 37-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Megevand et al. (Experimental & Applied Acrology (1993) Volume 17, pages 115-128) in view of Bjornson et al (US 5,206,568).

The instant claims are drawn to a method of aspirating fluid into a tip with two open ends, sealing one end after fluid is drawn into the tip, and using the sealed tip as a reservoir for further dispensing or mixing.

Regarding claims 12, 29, and 30-33, Megevand et al. teach a method of aspirating material into a dispensing tip with two open ends and sealing one end after

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material is aspirated into the dispensing tip (page 120, 3rd paragraph from the top).

Megevand et al. also teach sealing the tip with paraffin, which would require Megevand et al. to press (i.e., compress or plug) the paraffin onto the opening of the tip.

However Megevand et al. do not teach inserting a second dispensing tip through the open first end of the sealed tip and aspirating fluid from that end, nor do they teach dispensing a diluent or reagent in the first tip from a second tip to form a mixture.

Regarding claims 12, 29 and 30-33, Bjornson et al. teach a method of aspirating a fluid into a reservoir (column 13, lines 13-30; column 21, lines 50-61; column 22, lines 31-46; column 5, lines 50-68); inserting a second dispensing tip in said sample reservoir and aspirating a portion or all of said fluid from said sample reservoir into said second dispensing tip (column 10, lines 1-44); or withdrawing a reagent into a second dispensing tip and dispensing the reagent through the first end of the sample reservoir to form a mixture (column 10, lines 1-44; column 22, lines 31-46; column 24, line 8- column 26, line 54).

It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the methods of Megevand et al. and Bjornson et al. to gain the advantage of minimizing transfer loss. Megevand et al. teach a method that allows the practitioner to aspirate material directly into a reservoir with having to transfer that material into another receptacle. Since Megevand et al. eliminates the need for a transfer step, the transfer loss is minimized. Such a method would be advantage for working with small quantities of fluid. Bjornson et al.'s method is designed to work with small quantities of fluid typically used in analytical chemistry (Bjornson et al., abstract).

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Furthermore, Bjornson et al. teach that their method may be used with any fluid receptacle (Bjornson et al., column 5, lines 50-68). Thus one of ordinary skill in the art using Bjornson et al.'s method would be motivated to also use Megevand et al.'s method to minimize the transfer loss of fluids.

Regarding claims 13, 15, 18, and 36, Megevand et al. teach sealing the tip with paraffin, which would require Megevand et al. to press (i.e., compress or plug) the paraffin onto the opening of the tip, as well as move (displace) the material inside the tip away from the sealable end.

Regarding claims 16, 17, 20, 22, 34, 35, and 37- 40, Bjornson et al. also teach wherein the steps are preformed by a chemistry analyzer apparatus (Abstract); where the steps are manually performed (column 1, lines 30 – 54); wherein the second dispensing tip is sized to reach the second end of the reservoir (column 35, lines 3-40); wherein the step of withdrawing is followed by removing the mixture into the second dispensing tip and dispensing the mixture into the reservoir which is repeated (column 35, lines 3-40).

Response for Arguments

4. The Applicants have responded to this rejection by stating that Megevand et al. does not teach aspirating fluid, rather Megevand et al. teaches aspirating mites. The Examiner agrees and noted that in rejection above. However, Bjornson et al. does teach aspirating fluid. The rejection is based on the combination of Megevand et al. and Bjornson et al., wherein Megevand et al.'s method is used to aspirate fluid as taught by

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Bjornson et al. The rejection is not based on the references individually. Thus in combination, Megevand et al. and Bjornson et al. teach the instant limitation.

The Applicants also argue that neither Bjornson et al. or Ebersol et al. teach "withdrawing fluid into a first dispensing tip having an open first end and an open second end, and sealing the open second end of the first dispensing tip containing the fluid to form a sealed dispensing tip having an open first end and a close second end and defining a sample reservoir containing the fluid." The Examiner agrees that neither Bjornson et al. or Ebersol et al. teach every component of the above limitation. However, the rejection is based on the combination of Megevand et al., Bjornson et al. and Ebersol et al. The combination of the references does teach the instant limitation.

5. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Megevand et al. (Experimental & Applied Acrology (1993) Volume 17, pages 115-128) , in view of Bjornson et al. (US 5,206,568) further in view of in view of Ebersol et al. (US 5,578,460).

Megevand et al. and Bjornson et al. are applied as above.

Neither Megevand et al. or Bjornson et al. teaching sealing the tip by heat.

Regarding claim 14, Ebersole et al. teach method where a dispensing tip with a first and second end, wherein the second end is sealed with heat and defines a sample reservoir (column 24, line 64-column 25, line 18).

It would have been obvious for one of ordinary skill in the art at the time of the invention to combine the references of Megevand et al., Bjornson et al., and Ebersole et

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al. to gain the advantage of a permanent seal of the first tip. The motivation to combine Megevand et al. and Bjornson et al. is applied as above. Although Megevand et al. teach a method of sealing the tip with paraffin, their method is intended to only be a temporary seal. Such a seal would not be sufficient for experiments that require vigorous shaking or centrifuging. Thus one of ordinary skill in the art would be motivated to find a permanent seal. Ebersole et al. teach a method of creating a permanent seal by melting the end of the tip. Thus one of ordinary skill in the art seeking to conduct chemical analysis using Bjornson et al.'s apparatus, minimizing transfer loss, and creating a permanent seal would be motivated to combine the methods of Megevand et al., Bjornson et al., and Ebersole et al.

Response to Arguments

6. In response to this rejection, the Applicants argue that neither Bjornson et al. or Ebersol et al. teach "withdrawing fluid into a first dispensing tip having an open first end and an open second end, and sealing the open second end of the first dispensing tip containing the fluid to form a sealed dispensing tip having an open first end and a close second end and defining a sample reservoir containing the fluid." Please see above for the Examiner's response.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerry Lin whose telephone number is (571) 272-2561. The examiner can normally be reached on 10:00am-6:30pm M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang, can be reached on (571) 272-0811. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic

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Business Center (EBC) at 866-217-9197 (toll-free). Representatives are available to answer your questions daily from 6 am to midnight (EST). When calling please have your application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public.

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MICHAEL BORIN, PH.D
PRIMARY EXAMINER

JL

